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Nicholas J. Seay Quarles & Brady LLP 1 South Pinckney Street P.O. Box 2113 Madison, WI 53701-2113				
EXAMINER				
MORGAN, ROBERT W				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/052,659

Applicant(s)

DVORAK ET AL.

Examiner

ROBERT W. MORGAN

Art Unit

3626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 2/4/09. Claims 1-8 and 14-20 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morange et al., (U.S. Pub. 2005/0102374) in view of Felsher, (U.S. Pub. 2002/0010679), and Smithies et al. (U.S. Patent No. 5,544,255).
3. As per claim 1, Morange et al. discloses a system for distributed computing in which multiple different applications are in use connected on a common computer network, (Morange et al., Abstract; Fig. 19A-C; ¶ 50, 255-326) (disclosing a comprehensive Universal Software Platform).

Felsher fails to explicitly disclose such a platform, however, it is likely that such a distributed computing platform is inherent in the system disclosed by Felsher due to the disclosure of multiple different applications within the system, (Felsher ¶ 10, 91, 94, 120-188, 249). Felsher further discloses comprising a clinical exchange server on the network, the clinical exchange server including memory, (Felsher Fig. 1, and 2), the clinical exchange server programmed:

- (i) to maintain a reference table, the reference table including a list of applications on the network and information about the patient identification number used by each application, (Felsher, ¶ 266-268,279).
- (ii) to maintain a list of events reported to it by other applications on the network, (Felsher, ¶ 266-268,279) and
- (iii) to respond to inquiries from a first application about an event recorded by a second application by transmitting a query to the second application based on the information in the reference table and the list of reported events, (Felsher ¶ 264).

It would be obvious to one of ordinary skill in the art at the time of the invention to combine Morange et al. and Felsher. The motivation would have been to provide an infrastructure for efficient transmission, use and security protection of electronic medical records, (see: Felsher, Abstract, ¶ 14).

In addition, neither reference explicitly teaches different identification numbers. Smithies et al., however, does teach wherein the application distinct identification numbers include a first identification number used by a first application and a second identification number used by a second application where the second identification number is different than the first identification number (see: column 18, lines 5-56 of Smithies et al.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the systems of Morange et al. and Felsher. One of ordinary skill in the art would have been motivated to combine these features in order to determine an identity (see: column 17, lines 22-25 of Smithies et al.).

4. As per claim 2, Morange et al., Felsher, and Smithies et al. teach the system of claim 1 as

described above. Felsher further discloses a system wherein the clinical exchange server also maintains an abstract about the events sent to it to facilitate exchange of information between the applications, (Felsher, ¶ 266-268,279) (transactions are events, and an index of transaction records is considered to be an abstract of such events).

5. As per claim 3, Morange et al., Felsher, and Smithies et al. teach the system of claim 1 as described above. Felsher further discloses a system wherein the reference table includes a master patient index identification code assigned to the patient as well as the application specific identification code assigned to the patient by each application, (Felsher, ¶ 266-268,274, 279) (disclosing both indexed codes and an application-specific rolling code changed after each access).

6. As per claim 4, Morange et al., Felsher, and Smithies et al. teach the system of claim 1 as described above. Felsher further discloses a system wherein the clinical exchange server also stores health insurance information about each patient so that such health insurance information can easily be accessed by any of the applications, (Felsher, ¶ 318) (the system is HIPAA compatible, thus it is obvious that the system handles health insurance information, such as claim information).

7. As per claim 5, Felsher discloses a computer network for operation by a healthcare delivery enterprise, the network including a plurality of servers, the network comprising a clinical exchange server including a storage device, (Felsher, Fig. 1, ¶ 328) (disclosing (6) an entrusted medical information database), the clinical exchange server programmed to store in the storage device a reference table, the reference including a master patient identifier for each patient, and any separate identifying code used for the patient by any of the application

programs, so that the identifying code used by an application for a patient can be found by accessing the reference table, (Felsher, ¶ 266-268, 279, 334-339) (the patient medical information trust index is a form of reference table that stores a patient I.D used by the encryption application and other recipient applications and applets).

the clinical exchange server further programmed to facilitate information exchange between the applications by using the reference table to extract information from an application requested by another application, (Felsher, ¶ 132, 164-167, 266-272, 279, 334-339) (disclosing query applications that can be used with the reference table).

Felsher fails to expressly disclose operating a plurality of application programs and a list of application programs. However, it is likely that such a plurality of application programs and a list of application programs is inherent in the system disclosed by Felsher due to the disclosure of multiple different applications within the system, (Felsher ¶ 10, 91, 94, 120-188, 249).

Furthermore, Morange et al. discloses a system operating a plurality of application programs and a list of application programs, (Morange et al., Abstract; Fig. 19A-C; ¶ 50, 255- 326) (disclosing a comprehensive Universal Software Platform).

In addition, neither reference explicitly teaches different identification numbers. Smithies et al., however, does teach wherein the application distinct identification numbers include a first identification number used by a first application and a second identification number used by a second application where the second identification number is different than the first identification number (see Column 18, lines 5-56 of Smithies et al.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the systems of Morange et al. and Felsher. One of ordinary skill in

the art would have been motivated to combine these features in order to determine an identity (see column 17, lines 22-25 of Smithies et al.).

8. As per claim 6, Morange et al., Felsher, and Smithies et al. teach the computer network of claim 5 as described above. Felsher further discloses a computer network wherein the clinical exchange server also maintains a table of events associated with patients, the table of events including identifying information about the events and the identification of the application holding information about the event, (Felsher, 266-272) (transaction records are considered to be a table of events).

The statement of obviousness and motivation to combine is as disclosed in the rejection of claim 1 and incorporated herein by reference.

9. As per claim 7, Morange et al., Felsher, and Smithies et al. teach the computer network of claim 6 as described above. Felsher further discloses a computer network wherein the event table also includes an abstract about each of the events, (Felsher, 266-272) (A descriptive header is considered to be a form of abstract).

The statement of obviousness and motivation to combine is as disclosed in the rejection of claim 1 and incorporated herein by reference.

10. Claims 8 and 19-20 contain the same or substantially similar limitations as claims 4, 1, and 1 (respectively) and therefore the reasons for the rejection of claims 4, 1, and 1 are incorporated herein by reference.

11. Method claims 14-18 substantially repeat the subject matter of claims 1-4 as a series of steps rather than as a set of “means-plus-function” elements. As the underlying system has been shown to be fully disclosed by the teachings of Morange et al., Felsher, and Smithies et al. in the

above rejection of claims 1-8, it is readily apparent that the Morange et al., Felsher, and Smithies et al. references include a method. As such, these limitations are rejected for the same reasons provided in the rejection of claims 1-8 and incorporated herein.

Response to Arguments

12. Applicant's arguments filed 2/4/09 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 2/4/09.

(A) In the remarks, Applicants argue in substance that, (1) Neither Felsher nor Morange teaches a reference table that stores a list of applications and identification numbers used by the applications; (2) Felsher does not teach or suggest that a second query is generated for a second application in response to reception of a first query at an exchange server; (3) Smithies fails to teach or suggest a reference table including both a list of applications and associated patient identifiers; (4) Smithies does not teach that a list of applications is stored along with the person identifiers; and (5) Morange, Felsher and Smithies fail to teach or suggest responding to an inquiry from a first application by transmitting a query to a second application based on information in the reference table.

(B) In response to Applicant's argument that, (1) Neither Felsher nor Morange teaches a reference table that stores a list of applications and identification numbers used by the applications; (2) Felsher does not teach or suggest that a second query is generated for a second application in response to reception of a first query at an exchange server; (3) Smithies fails to teach or suggest a reference table including both a list of applications and associated patient identifiers; (4) Smithies does not teach that a list of applications is stored along with the person

identifiers; and (5) Morange, Felsher and Smithies fail to teach or suggest responding to an inquiry from a first application by transmitting a query to a second application based on information in the reference table. The Examiner respectfully submits that Morange is relied on for teaching a universal software platform (199, Fig. 19-20) including communications and transactions on a RAN global network (108, Fig. 19-20) and any other network(s) (see: paragraph 255-326). Felsher is relied on for teaching an extensible database architecture that provides data records relating to patient transaction and each transaction is indexed by a patient identifier (see: paragraph 266). In addition, Felsher teaches that the patient medical information trust index is a form of reference table that stores a patient I.D used by the encryption application and other recipient applications and applets (see: paragraphs 266-268, 279, 334-339). Smithies is relied on for teaching a person registered with the client application (2, Fig. 8) using a unique ID for application called AID and additionally, an application (2, Fig. 8) can register a person with itself using application's unique person-identifier (AUID) (see: column 18, lines 5-56). Thus, the combination of Morange, Felsher and Smithies teach the limitations of Applicant's claimed invention.

In addition, the Examiner respectfully notes that the cited reference was never applied as a reference under 35 U.S.C. 102 against the pending claims. As such, the Examiner respectfully submits that the issue at hand is not whether the applied prior art specifically teaches the claimed features, *per se*, but rather, whether or not the prior art, when taken in combination with the knowledge of average skill in the art, would put the artisan in possession of these features. Regarding this issue, it is well established that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545

(CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lahu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

As such, it is respectfully submitted that Applicant appears to view the applied reference in a vacuum without considering the knowledge of average skill in the art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT W. MORGAN whose telephone number is (571)272-6773. The examiner can normally be reached on 9:00 a.m. - 5:30 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert Morgan/
Primary Examiner, Art Unit 3626

